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## FAX TRANSMISSION

DATE: January 20, 2006

PTO IDENTIFIER: Application Number 10/002,854-Conf. #3669  
Patent Number

Inventor: Mark C. Poznansky et al.

MESSAGE TO: US Patent and Trademark Office

FAX NUMBER: (571) 273-8300

FROM: EDWARDS ANGELL PALMER & DODGE LLP  
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Attorney Dkt. #: 62053CIP(51588)

PAGES (Including Cover Sheet): 8

CONTENTS:  Transmittal (1 page)  
 Fcc Transmittal (1 page)  
 Petition under 37 CFR 1.181 ( 4 pages)  
 Certificate of Transmission (1 page)

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PTO/SB/97 (09-04)

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Application No. (if known): 10/002,854      Attorney Docket No.: 62053CIP(51588)**Certificate of Transmission under 37 CFR 1.8**

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on January 20, 2006  
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Transmittal (1 page)  
Fee Transmittal (1 page)  
Petition under 37 CFR 1.181 ( 4 pages)

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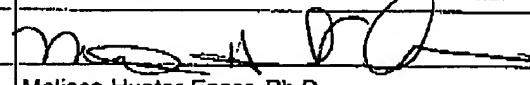
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Total Number of Pages in This Submission	Attorney Docket Number
62053CIP(51588)	

## ENCLOSURES (Check all that apply)

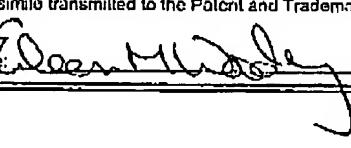
<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Reply	<input checked="" type="checkbox"/> Petition under 37 CFR 1.181	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation, Change of Correspondence Address	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Terminal Disclaimer	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Request for Refund	Charge \$400.00 to deposit account No. 04-1105
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> CD. Number of CD(s) _____	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Landscape Table on CD	
<input type="checkbox"/> Reply to Missing Parts/Incomplete Application	Remarks	
<input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53		

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	EDWARDS ANGELL PALMER & DODGE LLP		
Signature			
Printed name	Melissa Hunter-Ensor, Ph.D.		
Date	January 20, 2006	Reg. No.	55,289

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**PETITION FEE****Under 37 CFR 1.17(f), (g) & (h)  
TRANSMITTAL**

(Fees are subject to annual revision)

Send completed form to:  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Application Number	10/002,854-Conf. #3669
Filing Date	November 1, 2001
First Named Inventor	Mark C. Poznansky
Art Unit	1651
Examiner Name	L. B. Lankford
Attorney Docket Number	62053CIP(51588)

Enclosed is a petition filed under 37 CFR 1.181 that requires a processing fee (37 CFR 1.17(f), (g), or (h)). Payment of \$ 400.00 is enclosed.

This form should be included with the above-mentioned petition and faxed or mailed to the Office using the appropriate Mail Stop (e.g., Mail Stop Petition), if applicable. For transmittal of processing fees under 37 CFR 1.17(l), see form PTO/SB/17l.

**Payment of Fees** (small entity amounts are NOT available for the petition fees).

The Commissioner is hereby authorized to charge the following fees to Deposit Account No. 04-1105 :

Petition fee under 37 CFR 1.17(f), (g) or (h)  Any deficiency of fees and credit of any overpayments  
Enclose a duplicative copy of this form for fee processing.

Check in the amount of \$ \_\_\_\_\_ is enclosed.

Payment by credit card (Form PTO-2038 or equivalent enclosed). Do not provide credit card information on this form.

**Petition Fees under 37 CFR 1.17(f): Fee \$400 Fee Code 1462**

For petitions filed under:

§ 1.53(e) – to accord a filing date.  
§ 1.57(a) – to accord a filing date.  
§ 1.182 – for decision on a question not specifically provided for.  
§ 1.183 – to suspend the rules.  
§ 1.378(e) – for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.  
§ 1.741(b) – to accord a filing date to an application under § 1.740 for extension of a patent term.

**Petition Fees under 37 CFR 1.17(g): Fee \$200 Fee Code 1463**

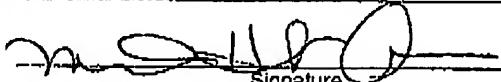
For petitions filed under:

§ 1.12 – for access to an assignment record.  
§ 1.14 – for access to an application.  
§ 1.47 – for filing by other than all the inventors or a person not the inventor.  
§ 1.50 – for expungement of information.  
§ 1.103(a) – to suspend action in an application.  
§ 1.138(b) – for review of a request for extension of time when the provisions of section 1.136(e) are not available.  
§ 1.205 – for review of refusal to publish a statutory invention registration.  
§ 1.296 – to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.  
§ 1.377 – for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.  
§ 1.550(c) – for patent owner requests for extension of time in *inter partes* reexamination proceedings.  
§ 1.956 – for patent owner requests for extension of time in *inter partes* reexamination proceedings.  
§ 5.12 – for expedited handling of a foreign filing license.  
§ 5.15 – for changing the scope of a license.  
§ 5.25 – for retroactive license.

**Petition Fees under 37 CFR 1.17(h): Fee \$130 Fee Code 1464**

For petitions filed under:

§ 1.19(g) – to request documents in a form other than that provided in this part.  
§ 1.84 – for accepting color drawings or photographs.  
§ 1.91 – for entry of a model or exhibit.  
§ 1.102(d) – to make an application special.  
§ 1.138(c) – to expressly abandon an application to avoid publication.  
§ 1.313 – to withdraw an application from issue.  
§ 1.314 – to defer issuance of a patent.



Signature

January 20, 2006

Date

Melissa Hunter-Ensor, Ph.D.

Typed or printed name

55,289

Registration No., if applicable

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JAN 20 2006

Docket No.: 62053C1P(51588)  
(PATENT)

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Mark C. Poznansky et al.

Application No.: 10/002,854

Confirmation No.: 3669

Filed: November 1, 2001

Art Unit: 1651

For: CAR RECEPTOR AS A MEDIATOR OF  
MIGRATORY CELL CHEMOTAXIS AND/OR  
CHEMOKINESIS

Examiner: L. B. Lankford

PETITION UNDER 37 CFR 1.181

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicants hereby petition the Commissioner for Patents under 37 CFR 1.181 to withdraw the finality of the office action mailed March 30, 2005 in application serial number 10/002,854. Applicants further petition under 37 CFR 1.183 to suspend the rule requiring a request for reconsideration under 37 CFR 1.111, in the event that the Commissioner deems it necessary in these circumstances. The Applicants believe that the extraordinary circumstances set forth below warrant grant of this combined petition.

Statement of facts

The Office mailed a final rejection in the above-referenced case (US Serial Number 10/002,854) on March 30, 2005. In response, Applicants timely filed an amendment under 37 CFR 1.116 on June 30, 2005. Applicants' attorney phoned the Examiner on July 27, 2005 to discuss the amendment and was informed that the amendment did not place the application in condition for allowance and that an Advisory Action would be forthcoming. Applicants then filed a Notice of Appeal on 8/1/2005. Applicants' attorney placed several subsequent telephone

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Docket No.: 62053CIP(51588)

calls inquiring as to the status of the application and when an Advisory Action would be mailed. The Advisory Action and Telephone Summary Record inviting a subsequent interview were not mailed until December 8, 2005, over five (5) months from the date of Applicants' amendment. The reason(s) for the Office delay is unclear. Further, the Advisory Action failed to note whether the Applicants' amendment had been entered (See Advisory Action mailed December 8, 2005; item 7 where neither box (a) nor box (b) is checked). However, as has been subsequently learned from checking the public PAIR site, the first page of Applicants Amendment after final shows the Examiner's initials beneath the words "OK to enter" in the margin. Thus, while Applicants may now presumably assume that the amendment was entered for the purposes of appeal, it is undisputed that this information was not timely communicated to the Applicants.

During a recent phone conversation with the Examiner on January 6, 2006, the Examiner indicated that, while he sympathized with the Applicants for the difficulties caused by the substantial Office delay in issuing the Advisory Action, he lacked the grounds to restart the period for reply and that the only recourse would be for Applicants to file an RCE. Applicants respectfully request that the Office reconsider its decision to maintain the finality of the Office action and to restart the shortened statutory period for response.

#### Issues in Examination

As of the final rejection, the only rejection of remaining was under 35 USC 103 over Yamaguchi et al, (*J. Bone Min. Research* Vol. 10(13)1530, 1998) which was directed to the in vitro investigations of certain compounds on MC3T3-E1 cells derived from mouse calvaria and having an osteoblast-like phenotype. In an effort to clarify the invention, the amendment narrowed the claims to hematopoietic cells distinguishing the invention from Yamaguchi et al. The Advisory Action asserted that the amendment was unsuccessful in avoiding the rejection because "Applicant argues that there is no reasonable expectation of success to extrapolate the Yamaguchi reference teachings to the in vivo effect on hematopoietic cells however it is unclear where applicant has demonstrated this and applicant would seem to depend on a like extrapolation with only a suggestion of in vivo use." See Advisory Action; continuation of 11. In fact, the application, as originally filed, contains in vitro and in vivo data and evidence directed to the impact of compounds on hematopoietic cells, in particular monocytes, as well as

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in vitro data on peripheral blood cells and hematopoietic progenitor cells (all hematopoietic cells). Thus, the Examiner's reason for maintaining the rejection is technically flawed. Indeed, the Interview Summary Record of July 27, 2005 invited a subsequent interview, presumably to discuss the merits of the statements in the Advisory Action. However, because of the delay in advising the Applicants of the grounds for maintaining the rejections, Applicants have been procedurally denied the opportunity to correct the technical misunderstanding. This is not the fault of Applicants or caused by the Applicants delay. It is caused by the PTO delay in mailing the Advisory Action.

Action requested by Applicants

In light of Office's failure to timely mail a complete advisory action within the required timeframe, and the refusal to remedy the problem by restarting the period for reply, Applicants request that the Director grant the instant petitions.

The lateness and cryptic nature of the Advisory Action has consequently precluded Applicant from making a timely request for reconsideration as required by 37 CFR 1.116 to correct the apparent technical misunderstandings made by the Examiner as to the content of the specification. Applicants should have been entitled to have such arguments presented in a second submission under 37 CFR 1.116 as they were raised for the first time in the Advisory Action. Applicants could not have anticipated that the Examiner would apparently mistakenly conclude (1) that in vitro studies of an osteoblastic-like clonal cell line derived from calvaria (not marrow) would render obvious in vivo studies of hematopoietic cells or (2) that that monocytes, peripheral blood cells and hematopoietic progenitor cells are not hematopoietic cells. Further, the lateness and incomplete nature of the Advisory Action has obviously frustrated the Applicants' ability to prepare a convincing and meaningful brief on appeal. For instance, the status of the entry of the amendment and the claims to be appealed has only been recently revealed to the Applicants. Of course, any brief on appeal must present arguments relevant to the appealed claims. In this case, since the Examiner's rejection, as maintained in the Advisory Action, appears to contain a fundamental technical misunderstanding, the issues on appeal cannot yet be said to be ripe. Further, these substantial delays will be assumed to be Applicant delays for the purposes of patent term adjustment if the Applicant pursues the appeal and filing

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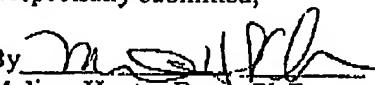
an RCE will completely eliminate the substantial Office delays that have been incurred to date. The loss of term where the Applicant has been very diligent is fundamentally unfair. This situation is not unlike the situation set forth in MPEP Section 710.06 where an office action is defective (for example, omitting an indication that an amendment was entered). In these cases, the MPEP suggests that the shortened statutory period for reply be restarted. Applicants, in contacting the Examiner on September 21, 2005, October 27, 2005, and November 1, 2005, have timely pointed out the omissions in the Advisory Action and the undue delay in receiving the Action. This petition follows the Examiner's denial of Applicants' request.

Applicants therefore respectfully request that in the interest of equity, the Director in his discretion grant Applicants' petition, order that the finality of the last action by the Office be withdrawn and that the Office issue a new Action restarting the statutory period for reply, and preserving Applicants' earned patent term adjustments.

The Director is hereby authorized to charge the fee set forth under 37 CFR 1.17(f) in the amount of \$ 400.00 to Deposit Account No. 04-1105. No additional fee is believed due to consider this position; however, the Director is hereby authorized to charge any deficiency or credit any overpayment in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 04-1105, under Order No. 62053 (51588).

Dated: January 20, 2006

Respectfully submitted,

By   
Melissa Hunter-Ensor, Ph.D.Registration No.: 55,289  
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